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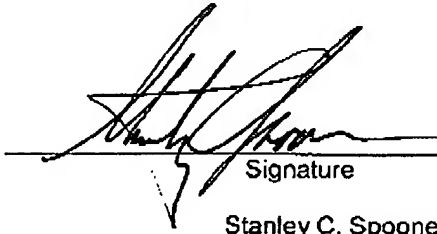
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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)
		SCS-124-1104
Application Number	Filed	RECEIVED CENTRAL FAX CENTER MAY 02 2008
10/522,988	February 2, 2005	
First Named Inventor		
BARNES		
Art Unit	Examiner	
2814	A. Kalam	
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the <input type="checkbox"/> Applicant/Inventor</p> <p><input type="checkbox"/> Assignee of record of the entire interest. See 37 C.F.R. § 3.71. Statement under 37 C.F.R. § 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> Attorney or agent of record 27,393 (Reg. No.)</p> <p><input type="checkbox"/> Attorney or agent acting under 37CFR 1.34. Registration number if acting under 37 C.F.R. § 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.*</p> <p><input checked="" type="checkbox"/> *Total of 1 form/s are submitted.</p>		


Signature
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May 2, 2008
Date

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STATEMENT OF ARGUMENTS IN SUPPORT OF
PRE-APPEAL BRIEF REQUEST FOR REVIEW

The following listing of clear errors in the Examiner's rejection and his failure to identify essential elements necessary for a *prima facie* basis of rejection is responsive to the Final Official Action mailed January 2, 2008 (Paper No. 20071227).

Independent claim 1 recites that with respect to "at least one layer" the claimed "thin semitransparent metal" electrode is "covering and separating said layer from air" (emphasis added). Independent claims 11-14 recite the "at least one layer" and that the electrode is "a thin transparent metal covering said layer." During a telephone interview with Examiner Kalam and his Primary Examiner Cao on May 2, 2008, a discussion was had of the definitions of the above three claim terms with no resolution. In a subsequent telephone discussion with Examiner Kalam, applicant offered to amend the claim language to add the redundant term "entire" to the phrase, i.e., to recite "said entire layer" if entered and considered, but this attempted compromise was rejected as requiring further consideration and/or search.

It was further pointed out in the telephone interview that the Examiner is bound by the MPEP §2111 mandate requiring that claims be "given their broadest reasonable interpretation consistent with the specification." (emphasis added). This MPEP language appears to be a paraphrase of the Federal Circuit's language that the broadest reasonable construction be "in light of the specification as it would be interpreted by one of ordinary skill in the art" The Examiner did not dispute that the specification was consistent with Appellant's claim construction and at odds with the Examiner's. He merely said that specification limitations would not be read into the claims.

The Examiner's claim constructions which hold "said layer" to mean something less than the entire "at least one layer" or that "coverage" could be less than covering the entire "at least one

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layer” or that “separating said layer from air” could mean separating only a portion of said layer from air, are simply not a “reasonable interpretation consistent with the specification” as required.

Error #1. The Examiner fails to properly construe independent claims 1 & 11-14, i.e., “said layer”

Each of pending independent claims 1 and 11-14 specify “said layer” in the phrases “covering and separating said layer from air” (claim 1) and “covering said layer” (claims 11-14). The antecedent basis for “said layer” is the reference to “at least one layer” in line 2 of each of the independent claims and, in accordance with PTO claiming practice, the reference to “said layer” must be construed to mean the previously recited “said at least one layer.”

The Examiner’s position is that the claim language “said layer” could be a reference to less than all of the recited “at least one layer” (and thus the claim should not be construed to read the entire previously specified layer and thus the prior art which discloses at best only partial covering of the layer is not distinguished). If the claim language instead recited “a portion of said layer” then the Examiner would have an argument. However, the claim does not include the language “a portion” or any other similar modifying adjective and thus, the plain meaning of the claim is the entire specified “at least one layer.”

The MPEP at section 2173.05(e) gives an example of indefiniteness that may be instructive. A claim is indefinite if the word “said” is used in conjunction with a narrower statement of a previous referenced structure. The MPEP example is that “said aluminum lever” is indefinite where the previous reference in the claim is only to “a lever.” Here, the Examiner’s construction of the term “said layer” is that it could somehow be broader than the previously recited “at least one layer”, i.e., to include both “said at least one layer” and “said portion of at least one layer.” This is, in fact, a reading into the claim of a limitation (“a portion of”) which simply does not exist, i.e., that

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“said layer” could mean less than all of “at least one layer.” If applicant attempted such reading, the claim would be indefinite and Examiner’s should also be precluded from such claim constructions.

None of the claims recite at least “a portion of said layer,” which is the manner in which the Examiner is apparently construing the claim. “Said layer” means the previously stated or said “at least one layer” – nothing more and nothing less. So the Examiner’s misconstruction of the claim language is reversible error.

Error #2. The Examiner fails to properly construe the phrase of independent claims 1 & 11-14 i.e., “covering . . . said layer from air”

Applicants pointed out that regarding claims 1 and 11-14, the common dictionary definition of the word “cover” without any further modifying adjective means “to lay or spread something over” (Webster’s Ninth New Collegiate Dictionary). Thus, without further modification (such as “partially covering”), the simple meaning of the word “cover” is to completely cover the referenced layer or to cover the entire layer.

Both the Examiner and his primary argued that the word “cover” does not by itself mean covering the entire layer and instead for the claim to have this meaning, the claim language would have to say covering “said entire layer.” While this language would also have the same import as the existing language, it is simply redundant – those of ordinary skill in the art clearly understand that, without any modifier, the word “cover” refers to fully covering the specified object, here the previously specified “at least one layer.” The prior art doesn’t show this feature of the claim and therefore the prior art does not support the rejection.

The “covering” of said “at least one layer” requires the application of the dictionary definition of “to lay or spread something over” and the thing which is to be covered is the entire “at

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least one layer.” The Examiner has committed reversible error in misconstruing the word “covering” to mean “partially covering.”

Thus, the Examiner’s construction of “covering” is inconsistent with (a) the ordinary dictionary definition, (b) the use of the term by those of ordinary skill, (c) the use of the term in the specification and is construed in a manner inconsistent with Federal Circuit precedent as recited in the MPEP.

Error #3. The Examiner fails to properly construe the claim 1 term “separating said layer from air”

Applicants pointed out that regarding claim 1, the common dictionary definition of the word “separating” without any further modifying adjective means “to set or keep apart” (Webster’s Ninth New Collegiate Dictionary). Thus, without further modification (such as “partially separating”), the simple meaning of the word “separate” is to completely set or keep apart the referenced layer (said “at least one layer”) and air.

Both the Examiner and his primary argued that the word “separate” does not by itself mean separating the entire layer and instead for the claim to have this meaning, the claim language would have to say “separating said entire layer from air.” While this language would also have the same import as the existing language, it is simply redundant – those of ordinary skill in the art clearly understand that, without any modifier, the word “separate” refers to fully separating the specified object, here the previously specified “at least one layer,” from air. The prior art doesn’t show this feature of the claim and therefore the prior art does not support the rejection.

The “separating” of said “at least one layer” requires the application of the dictionary definition of “to set or keep apart” and the things which are to be separated are the entire “at least

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one layer” and the recited “air.” The Examiner has committed reversible error in misconstruing the word “separating” to mean “partially separating said layer from air.”

Thus, the Examiner’s construction of “separating” is inconsistent with (a) the ordinary dictionary definition, (b) the use of the term by those of ordinary skill, (c) the use of the term in the specification and is construed in a manner inconsistent with Federal Circuit precedent as recited in the MPEP.

Error #4. The Examiner citation of Scherer fails to support the rejections under sections 102 or 103

It is apparent that the Scherer reference does not teach or suggest a metal electrode which either covers the recited “at least one layer” or separates “said layer from air.” The holes in Scherer do not cover the layer nor do they separate the layer from air. As a result, Scherer does not support any rejection under sections 102 or 103 and any further rejection thereunder is respectfully traversed.

SUMMARY

The Examiner has misconstrued the above noted claim terms. The prior art does not disclose the properly construed features of the independent claims or claims dependent thereon.

As a result of the above, there is simply no support for the rejection of Applicants’ independent claims or claims dependent thereon under 35 USC §102 and/or §103. Applicants respectfully request that the Pre-Appeal Panel find that the application is allowed on the existing claims and prosecution on the merits should be closed.